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In re Application of	:
Yin Hwee Tan et al	:
Serial No.: 09/914,184	: PETITION DECISION
Filed: November 16, 2001	:
Attorney Docket No.: 117-363	:

This is in response to the petition under 37 CFR 1.144, filed January 5, 2005, requesting withdrawal of an improper restriction requirement.

BACKGROUND

A review of the file history shows that this application was filed under 35 U.S.C. 371 and accepted on November 16, 2001, and contained claims 22-39, claims 1-21 having been canceled.. In a first Office action, mailed October 3, 2003, the examiner set forth a restriction requirement in accordance with PCT Rule 13.1 and 13.2 and 37 CFR 1.499, as follows:

Group I – Claims 30 and 39, drawn to a composition containing an interferon and a 5-membered nucleoside;

Group II – Claims 22-29, drawn to a method of treating a flavivirus or rhabdovirus infection with the composition of Group I;

Group III – Claims 31-37, drawn to a method of treating a flavivirus or rhabdovirus infection with an interferon.

The examiner reasoned that the groups were related as product and method of making or were methods of use unrelated to each other. The examiner also indicated that there would be a burdensome search.

Applicants replied on November 3, 2003, amending claims 22 and 29 and canceling claims 31-37 (Group III). Applicants then elected Group II and traversed the requirement as improper in that there was no undue burden since both inventions were classified in the same class and subclass and that the two groups form a general inventive concept which should not be held to lack unity under PCT rules.

The examiner mailed a new Office action to applicants on April 16, 2004, confirming applicants' election, affirming the restriction and making it Final due to undue search burden. The examiner also made rejections of the elected claims under 35 U.S.C. 112, second paragraph, for indefiniteness and under 35 U.S.C. 103(a) for obviousness. Applicants replied on August 16, 2004, by amending claims 22 and 28 and adding claims 40-41. Applicants replied to each of the rejections of record but did not offer any further traverse of the restriction requirement..

The examiner mailed a new non-Final Office action to applicants on November 15, 2004, setting forth a new rejection of all claims under 35 U.S.C. 103(a). No comment on the restriction requirement was made. Applicants filed this petition on January 5, 2005, requesting review of the restriction requirement and withdrawal thereof.

DISCUSSION

The claims as initially filed and now amended are drawn to a composition comprising an interferon and a second component of a nucleoside and a diamino pyrimidine and a method of treating a flavivirus or rhabdovirus using the composition.

The examiner based the reasoning for the initial restriction (actually a Lack of Unity) requirement on separation of product and process and undue search burden. Under PCT Rules, absent a clear indication that there is no special technical feature as shown by known art, products and methods of using the products are considered to be part of the same inventive concept and are not to be held to lack unity. In addition, search burden under PCT is not a criteria upon which Lack of Unity can be based. Thus the examiner's reasoning for holding Lack of Unity was not proper.

It is noted that in response thereto applicants correctly pointed out the examiner's error, but canceled all claims to one of the groups. Subsequently, in the last Office action, the examiner rejoined all pending method and product claims for examination purposes. In view of the rejoinder the issues petitioned herein have been resolved.

DECISION

The petition is **DISMISSED** as moot.

Applicants remain under obligation to reply to the Office action mailed November 15, 2004, within the time period set therein or as may be extended under 37 CFR 1.136(a).

Should there be any questions about this decision please contact William R. Dixon, Jr., by letter addressed to Director, TC 1600, at the address listed above, or by telephone at 703-308-3824 or by facsimile sent to the general Office facsimile number, 571-273-8300.



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